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Paper No.

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Williamsville NY 14221

**COPY MAILED**

**AUG 11 2008**

In re Application of :  
William J. Bonifacio et al. :  
Application No. 10/804,370 : DECISION ON PETITION  
Filed: March 19, 2004 : PURSUANT TO  
Title: MACHINE FOR REMOVING : 37 C.F.R. § 1.137(A)  
SUMP PIT WATER AND PROCESS FOR :  
MAKING SAME :

This is a decision on the petition filed July 21, 2008, pursuant to 37 C.F.R. § 1.137(a), to revive the above-identified application.

This petition is **DISMISSED**.

BACKGROUND

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action, mailed August 7, 2007, which set a shortened statutory period for reply of three months. No response was received, and no extensions of time under the provisions of 37 C.F.R. § 1.136(a) were requested. Accordingly, the above-identified application became abandoned on November 8, 2007. A notice of abandonment was mailed on May 16, 2008.

RELEVANT PORTIONS OF THE C.F.R.

37 C.F.R. § 1.134 sets forth, in toto:

Decision on Petition pursuant to 37 C.F.R. § 1.137(a)

An Office action will notify the applicant of any non-statutory or shortened statutory time period set for reply to an Office action. Unless the applicant is notified in writing that a reply is required in less than six months, a maximum period of six months is allowed.

37 C.F.R. § 1.135 sets forth, *in toto*:

(a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.

(b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.

(c) When reply by the applicant is a bona fide attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

#### THE APPLICABLE STANDARD

Nonawareness of a PTO rule will not constitute unavoidable delay<sup>1</sup>

The burden of showing the cause of the delay is on the person seeking to revive the application.<sup>2</sup>

"[T]he question of whether an applicant's delay in prosecuting an application was unavoidable must be decided on a case-by-case basis, taking all of the facts and circumstances into account."<sup>3</sup> The general question asked by the Office is: "Did petitioner act as a reasonable and prudent person in relation to his most important business?"<sup>4</sup>

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<sup>1</sup> See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel's nonawareness of PTO rules does not constitute "unavoidable" delay)). Although court decisions have only addressed the issue of lack of knowledge of an attorney, there is no reason to expect a different result due to lack of knowledge on the part of a pro se (one who prosecutes on his own) applicant. It would be inequitable for a court to determine that a client who spends his hard earned money on an attorney who happens not to know a specific rule should be held to a higher standard than a pro se applicant who makes (or is forced to make) the decision to file the application without the assistance of counsel. See also Donnelley v. Dickinson, 123 Fsupp2d 456, 459.

<sup>2</sup> Id.

<sup>3</sup> See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985).

<sup>4</sup> See In re Mattulah, 38 App. D.C. 497 (D.C. Cir. 1912).

A delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice, or the MPEP is not rendered "unavoidable" due to either the applicant's reliance upon oral advice from USPTO employees or the USPTO's failure to advise the applicant to take corrective action.<sup>5</sup>

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In re Mattullath, 38 App. D.C. at (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

A petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable."<sup>6</sup>

In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account."<sup>7</sup>

A petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable."<sup>8</sup>

#### ANALYSIS

A grantable petition pursuant to 37 C.F.R. § 1.137(a) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in 37 C.F.R. § 1.17(1);

<sup>5</sup> See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985).

<sup>6</sup> Haines, 673 F. Supp. at 314, 316-17; 5 USPQ2d at 1131-32.

<sup>7</sup> Smith v. Mossinghoff, 671 F.2d at 538; 213 USPQ at 982.

<sup>8</sup> Haines, 673 F. Supp. at 314, 316-17; 5 USPQ2d at 1131-32.

- (3) A showing to the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unavoidable;
- (4) Any terminal disclaimer (and fee as set forth in 37 C.F.R. § 1.20(d)) required pursuant to paragraph (d) of this section.

Receipt of the petition fee is acknowledged, along with a specification, claims, an abstract, and drawings. Petitioner has met the second requirement of Rule 1.137(a). The fourth requirement is not applicable, as a terminal disclaimer is not necessary. The first and third requirements of Rule 1.137(a) have not been met.

Regarding the first requirement, the requirement has not been satisfied because Petitioner did not submit the required reply to the Office action. The required reply is the reply sufficient to have avoided abandonment, had such reply been timely filed.<sup>9</sup> In order for the application to be revived, petitioner must submit a reply which satisfies 37 C.F.R. §1.137(a)(1) (i.e., either an amendment or arguments directed towards the non-final rejection). The petition was not accompanied by either an amendment or arguments directed towards the non-final rejection.

Regarding the third requirement, it has not been established that the entire period of delay was unavoidable.

Petitioner has indicated that the non-final Office action of August 7, 2007 was received, the two inventors commenced preparing a response, and co-inventor Belle's input was "integral" to the preparation of said response. However, in October of 2007, Mr. Belle "began to demonstrate increased symptoms of his already existing medical condition," and suffered serious medical problems that continue to this day. At an unspecified time, Mr. Belle became well enough to resume contributing to the preparation of said response.

Moreover, Petitioner has included:

- a copy of a document from "Erie County Medical Center Corporation," which contains writing that is illegible, and

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<sup>9</sup> See M.P.E.P. § 711.03(c).

as such, this paper has not been considered by the undersigned;

- papers related to smoking and heart disease;
- a listing of medications;
- two bills from the Twin City Ambulance Corporation, and
- a paper entitled "vascular access discharge orders/instructions."

On renewed petition, Petitioner must explain why he was unable to compose a response to the non-final Office action without the input of co-inventor Belle.

Petitioner's submission is being construed to contain an assertion that the entire period of delay was unavoidable due to the medical incapacitation of co-inventor Belle. Medical incapacitation is an avenue by which an applicant can successfully establish that the entire period of a delay was unavoidable. A showing of "unavoidable" delay based upon medical incapacitation must establish that the incapacitation of co-inventor Belle was of such a nature and degree as to render him unable to contribute in the preparation of a response to the non-final Office action.

However, it is noted that a statement from co-inventor Belle has not been provided. Petitioner cannot assert medical incapacitation on behalf of co-inventor Belle: on renewed petition, a statement from co-inventor Belle must be provided which asserts medical incapacitation during the entire period between November 8, 2007 until the filing of a grantable petition. Such a showing must be supported by a statement from co-inventor Belle's treating physician, and such statement must provide the nature and degree of petitioner's incapacitation during the above-mentioned period. More specifically, the statement from the physician should describe the debilitating effects of the injury, the debilitating effects of any resulting therapy, and the debilitating effects of any medication that Mr. Belle took during this period.

Furthermore, the renewed petition must contain an explanation of why a proper response was not provided with this petition. Petitioner should note that it is the entire period of delay, from the due date for the reply until the filing of a grantable petition, which must be shown to have been unavoidable.

Petitioner is cautioned to avoid submitting confidential information that may contribute to identity theft.

Specifically, Petitioner should consider redacting social security, bank account, or credit card numbers from any documents submitted to the USPTO. This type of personal data is never required by the USPTO to support a petition or an application. Petitioner is advised that any information submitted may be disclosed, as a routine use, to the public after either publication of the application, unless a non-publication request is made in the application, or issuance of a patent. Further, a record may be disclosed, subject to the limitations of 37 C.F.R. § 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection, or an issued patent.

If Petitioner has supplied papers that contain any of the above-identified confidential information that has not been redacted, Petitioner may provide a redacted copy of the same to the Office. If accompanied by a statement that the redacted version is identical to the originally submitted copy, but for the redactions, the redacted copy will be placed into the electronic file and the original electronic copy will be removed from view.

#### CONCLUSION

Any reply must be submitted within **TWO MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. § 1.136(a) are permitted. The reply should include a cover letter entitled "Renewed Petition pursuant to 37 C.F.R. § 1.137(a)".

This is not a final agency action within the meaning of 5 U.S.C § 704.

The renewed petition should indicate in a prominent manner that the attorney handling this matter is Paul Shanoski, and may be submitted by mail<sup>10</sup>, hand-delivery<sup>11</sup>, or facsimile<sup>12</sup>. Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web<sup>13</sup>.

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10 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

11 Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.

12 (571) 273-8300- please note this is a central facsimile number.

13 <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>

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If responding by mail, Petitioner is advised not to place the undersigned's name on the envelope. Only the information that appears in the footnote should be included - adding anything else to the address will delay the delivery of the response to the undersigned.

Alternatively, Petitioner may also file a petition pursuant to 37 C.F.R. § 1.137(b), which carries with it a much lower standard. Unless Petitioner believes that he can successfully establish that the entire period of delay was unavoidable, he may wish to file pursuant to the unintentional standard. Petitioner may download information about these petitions at: [http://www.uspto.gov/web/offices/pac/mpep/documents/0700\\_711\\_03\\_c.htm#sect711.03c](http://www.uspto.gov/web/offices/pac/mpep/documents/0700_711_03_c.htm#sect711.03c)

Telephone inquiries **regarding this decision** should be directed to the undersigned at (571) 272-3225<sup>14</sup>.

/Paul Shanoski/  
Paul Shanoski  
Senior Attorney  
Office of Petitions

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<sup>14</sup> Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for Petitioner's further action(s).